

LTH/Rebecca

Assistant Commissioner For Patents
Washington, DC 20231

Date Mailed: 6-18-99
Atty. Dkt. No. 5784-3

Application No. 09/187,661; Filing Date Nov. 6, 1998
Inventor(s): Shirley, et al.; Title of Invention: NOVEL IGF-I COMPOSITION
AND ITS USE"
Documents Enclosed: Response to Restriction Requirement

Check Enclosed n/a

Kindly acknowledge receipt by placing office stamp hereon and
returning postcard to: Leslie T. Henry
ALSTON & BIRD LLP

RTA01/2064557v1



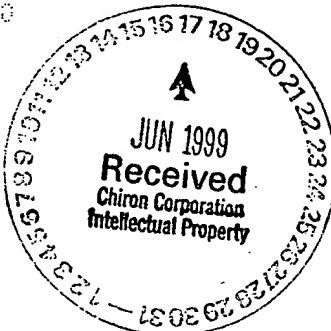
**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 057187, 051	FILING DATE 11/04/98	FIRST NAMED INVENTOR SHIRLEY	ATTORNEY DOCKET NO. 3784-3
--------------------------------	-------------------------	---------------------------------	-------------------------------

CHIRON CORPORATION
INTELLECTUAL PROPERTY-R440
P.O. BOX 8097
EMERYVILLE, CA 94662-8097

HM11/0604



EXAMINER HOOZIE, F

ART UNIT 1505	PAPER NUMBER
------------------	--------------

DATE MAILED: 06/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Mr. Spruill:

This action has been remailed. Time has also been restarted from 6/4/99. You may have the original mailed back to you. Please discard ~~that~~ previous action.

RECEIVED

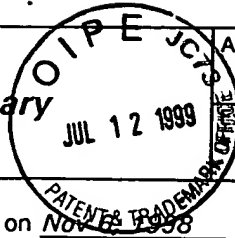
AUG 02 1999

**SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS**

Thank you,
Tina Plunkett
Legal Instrument Exm.
703-308-3951

DOCKETED on 6/17/99
by JHG
File # 1466, 052
Circ Date 7/4/99 R64
Mailed 11/4/99 R68

Office Action Summary



Application No.

09/187,661

Applicant(s)

Shirley et al

Examiner

Fatemeh Moezie

Group Art Unit

1654



☒ Responsive to communication(s) filed on Nov 12 1998

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire thirty month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-27 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

FH

Serial Number: 09/187,661

Art Unit: 1654



Page 2

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 8, 12, 13, 16-20, drawn to a composition comprising IGF-I, classified in class 514, subclass 12, for example.
 - II. Claims 5-7 (a); 9-11 (b); and 14-15 (c), drawn to three methods of preparing the above composition, classified in class 530, subclass 338, for example.
 - III. Claims 21-27, drawn to a method of use, classified in class 424, subclass 1.25, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by various processes such as process (a), (b) or (c).

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 1654

§ 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as IGF-II or insulin.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

A telephone call was made to attorney Murry Spruill (in accordance with attorney Guth's request) on 13 May 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication should be directed to Examiner F.T. Moezie at telephone number (703) 305-4508.

F. T. Moezie
F. T. MOEZIE, Ph.D.
PRIMARY EXAMINER
ART UNIT 1654